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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/899,874	07/05/2001	Mohsen Shahinpoor	2313-00	3330

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EXAMINER

NGUYEN, TAI V

ART UNIT	PAPER NUMBER
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3729

DATE MAILED: 05/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/899,874

Applicant(s)

SHAHINPOOR ET AL.

Examiner

Tai Van Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 July 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 13-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 and 8-12 is/are rejected.
- 7) ☒ Claim(s) 5-7 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 7/5/2001.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Specification

1. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.
2. Following title is suggested: A METHOD OF FRABRICATING A DRY ELECTRO-ACTIVE POLYMERIC SYNTHETIC MUSCLE.
3. Applicant is reminded of the proper content of an abstract of the disclosure.

A patent abstract is a concise statement of the technical disclosure of the patent and should include that which is new in the art to which the invention pertains. If the patent is of a basic nature, the entire technical disclosure may be new in the art, and the abstract should be directed to the entire disclosure. If the patent is in the nature of an improvement in an old apparatus, process, product, or composition, the abstract should include the technical disclosure of the improvement. In certain patents, particularly those for compounds and compositions, wherein the process for making and/or the use thereof are not obvious, the abstract should set forth a process for making and/or use thereof. If the new technical disclosure involves modifications or alternatives, the abstract should mention by way of example the preferred modification or alternative.

The abstract should not refer to purported merits or speculative applications of the invention and should not compare the invention with the prior art.

Where applicable, the abstract should include the following:

- (1) if a machine or apparatus, its organization and operation;
- (2) if an article, its method of making;
- (3) if a chemical compound, its identity and use;
- (4) if a mixture, its ingredients;
- (5) if a process, the steps.**

Extensive mechanical and design details of apparatus should not be given.

4. The abstract of the disclosure is objected to because the abstract is not drawn to the claimed invention, i. e. method. Correction is required. See MPEP § 608.01(b).

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1, 3 and 4 are rejected under 35 U.S.C. 102(b) as being anticipated by Kojima et al (US 5,424,907).

As applied to claim 1, Kojima et al disclose a method of fabricating a dry electro-active polymeric synthetic muscle, the method comprising the steps of: a) providing a polyelectrolyte material (such as a member conductive polymer film 18, Fig. 1); b) mixing the polyelectrolyte material with a conductive material (see column 4, lines 15-43); and affixing at least two electrodes (16, 20, Fig. 1) to the mixed polyelectrolyte material and conductive material.

As applied to claim 3, Kojima et al further discloses the step applying heat to the combined materials (column 6, lines 65-68).

As applied to claim 4, Kojima et al further discloses wherein the step of mixing comprises combining a dry polyelectrolyte material with a dry conductive material and applying pressure to the combined materials (see column 4, lines 27-38).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 2, 8 and 10-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kojima et al in view of Burgess (US 5,060,527).

As applied to claim 2, Kojima et al discloses substantially all of the limitations of the claimed invention except that the conducting is powder.

However, Burgess discloses conducting is powder metal (see column 4, line 226-29).

As applied to claim 8, Kojima et al discloses substantially all limitation of the claimed invention except that the interlocking primary electrically conductive particles with smaller conductive particles.

However, Burgess further discloses the interlocking primary electrically conductive particles with smaller conductive particles (see column 1, lines 50-64).

As applied to claims 10-12, Kojima et al discloses substantially all of the limitation of the claimed invention except that a sensing device, actuating device and a transducer device.

However, Burgess further discloses a sensing, actuating device and transducer devices (column 3, lines 62-66). The benefits of the above features of Burgess will

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have sufficient sensitive, consistent reproducibility, and high resolution (column 2, lines 3-10).

It would have been an obvious to one of ordinary skill in the art at this time the invention was made to have improved the method of Kojima et al by utilizing the interlocking primary electrically conductive particles as well as the products of the sensing, actuating and transducer device, as taught by Burgess, for the benefits of having sufficient sensitive, consistent reproducibility, and high resolution (column 2, lines 3-20).

9. Claim 9 is rejected under 103(a) as being unpatentable over Kojima et al in view of Meisel et al (US 5,638,205).

Kojima et al discloses substantially all of the limitations of the claimed invention except that the polyelectrolyte material in the group consisting of polyethylene oxide.

However, Meisel et al discloses polyelectrolyte material is a member of the group consisting of polyethylene oxide (see column 5, lines 50-53). It would have been an obvious to one of ordinary skill in the art at this time the invention was made to improve the method of Kojima et al by utilizing the material of Meisel to positively provide an alternative polyelectrolyte material.

Allowable Subject Matter

10. Claims 5-7 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tai Van Nguyen whose telephone number is 703-308-1791. The examiner can normally be reached on M-F (7:30-4:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Vo can be reached on 703-308-1789. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

TN.
May 19, 2004


A. DEXTER TUGBANG
PRIMARY EXAMINER